Office Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

NO. 766

BOWEN-ITCO, INC., AND LYNN W. STORM,
Petitioners,

v.

HOUSTON ENGINEERS, INC.,
Respondent.

IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

BRIEF FOR RESPONDENT

BROWNING, SIMMS, HYER & EICKENROHT
JAMES B. SIMMS
3400 Montrose Boulevard
Houston 6, Texas
Attorneys for Respondent

BORG PRINTING COMPANY OF TEXAS, HOUSTON, TEXAS

INDEX

	Page
Statement of the Case	1
Argument	2

LIST OF AUTHORITIES

Cases Cited

Muncie Gear Works v. *Outboard, M. & Mfg. Co.*, 315 U.S. 759-768; 86 L. ed. 1171, 1178	3
Smith v. *Magic City Kennel Club*, 282 U.S. 784; 75 L. ed. 707	3

Statutes

28 U. S. Code, Section 2106	2

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STATEMENT OF THE CASE

It is believed that a slight expansion or clarification of the Statement of the Case will aid the Court.

The statements in the Opinion of the Court of Appeals which the Petitioners call "Findings of Fact" are merely statements contained in the File Wrapper of the reissue patent in suit. There is no fact controversy as to either the

content or existence of the File Wrapper. The only controversy is as to the legal effect of the statements.

The File Wrapper was placed in evidence by Petitioners as a certified copy of the Patent Office file. It contains the application for the reissue patent as originally filed and copies of the correspondence between the Examiner and the attorney for the applicant (Plaintiffs' Exhibit 4, R. 677-737, inclusive).

ARGUMENT

The question as phrased in the Petition is extremely general in referring to a "crucial issue". The question is much more specific because the so-called "crucial issue" is specific; namely, the legal effect of the File Wrapper. Thus, the question is, in effect:

> Is it proper for an appellate court in reviewing an adjudication of patent infringement to refer to the File Wrapper of the patent in suit, and, where the uncontroverted facts therein contained preclude as a matter of law a ruling of infringement, to reverse with directions to enter judgment for the defendant?

This is what the Court of Appeals did in the instant case.

It is submitted that the Petition for Writ of Certiorari should be denied for each of the following reasons:

1. The Petition viewed as a whole does not provide any reasons of the character contemplated by Rule 19(1) for the issuance of the Writ.

2. 28 U.S.C. 2106 confers on appellate courts the right to reverse a judgment and to direct the entry of an appropriate judgment.

3. The question presented by the Petition, of whether or not the Court of Appeals has properly reversed the lower court without remand "with instructions to make Findings of Fact", has no uniqueness such as to justify the attention of this Court in this particular controversy. The decisions of this Court have settled the practice with respect to Rule 52(a) of the Federal Rules of Civil Procedure.

This Court has for example looked into the record, including the File Wrapper of a patent, and held it was not foreclosed from reversing on a "point by the obscurity of its presentation in the courts below" where the "issue has been fully presented to this Court by the petition for a writ of certiorari, and in subsequent briefs and arguments; and there is not the slightest indication that respondents have been prejudiced by such obscurity." *Muncie Gear Works* v. *Outboard, M. & Mfg. Co.*, 315 U.S. 759-768; 86 L. ed. 1171, 1178.[1]

On the other hand, where there are numerous conflicting fact issues on which there are no Findings of Fact, then the appellate court will remand for additional Findings of Fact. This was the situation in the cases urged by Petitioners in their brief. Thus, Petitioners' authorities are inapposite to the present case where there was no conflict in evidence, but which merely involved the legal effect to be accorded statements contained in the File Wrapper, a written exhibit.

4. The Court of Appeals would almost have been derelict in its duty, in the interest of judicial economy, to have taken any course other than that which it followed, in view of the circumstances of the instant case. The Court of Appeals having properly concluded that the legal effect of a document required a reversal,

[1] See also *Smith* v. *Magic City Kennel Club*, 282 U.S. 784, 75 L. ed. 707, where this Court affirmed a reversal of the District Court ruling of infringement, based on file wrapper estoppel.

what would be gained by a remand for further Findings of Fact?

Respectfully submitted,

BROWNING, SIMMS, HYER & EICKENROHT

By.....

JAMES B. SIMMS
3400 Montrose Boulevard
Houston 6, Texas

Attorneys for Respondent

CERTIFICATE OF SERVICE

I hereby certify that three copies of the foregoing Brief for Respondent were duly served upon Petitioners herein by depositing same in the United States mail, first class, postage prepaid, addressed to B. R. Pravel, 500 Jefferson Building, Suite 1111, Houston 2, Texas, attorney for Petitioners, this ..... day of February, 1963.

.....

JAMES B. SIMMS

Attorney for Respondent